

### **REMARKS**

Applicant respectfully requests reconsideration. Claims 1-6 and 45 were previously pending in this application. By this amendment, Applicant is amending claim 1 and adding new claims 46-48. As a result, claims 1-6 and 45-48 are pending for examination with claims 1 being the only independent claim. No new matter has been added.

#### ***Claim Rejections Under 35 U.S.C. §112***

The Examiner rejected claims 1-6 under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. In particular, the Examiner suggests that in claim 1, “therethrough” should be amended to recite “therethrough, the cylinder”. Applicant has amended claim 1 in the manner suggested by the Examiner to further the prosecution of the application.

Accordingly, withdraw of this rejection is respectfully requested.

#### ***Claim Rejections Under 35 U.S.C. §102***

The Examiner rejected claims 1-6, and 45 under 35 U.S.C. §102(e) as being anticipated by Bach (U.S. Patent Application No. 2005/0135952). Applicant respectfully traverses this rejection. Applicant has also amended claim 1 for further clarification.

As amended, independent claim 1 is directed to a pipette module including a channel block having at least one passage therethrough, a rod sized, shaped and aligned to pass into the channel block passage, and *a cylinder having a passage extending therethrough, where the cylinder* is sized, shaped and aligned to pass into the channel block passage from the end opposite the end which the rod passes. A chamber is defined by the channel block, rod, and cylinder, having a volume which is variable during the pipetting operation of the pipette module, with a first part of the chamber variable by relative movement of the channel block relative to the fixed relative positions of the rod and cylinder, and with a second part of the chamber variable by relative movement of the cylinder relative to the fixed relative positions of the rod and channel block.

The present application was filed on October 24, 2003, as a continuation-in-part of U.S. Application No. 10/443,350, which was filed on May 22, 2003. This priority chain is illustrated

in both the Declaration of the patent application executed by the Applicant, on the first page of the application, and in the Official Filing Receipt.

Independent claim 1 is supported by the earliest priority document, U.S. Application No. 10/443,350. In particular, the “channel block” in claim 1, is similar to the “housing 60” described and illustrated in U.S. Application No. 10/443,350, the “rod” in claim 1 is similar to the “piston 40”, and the “cylinder” in claim 1 is similar to the “plunger 20”. Accordingly, claim 1 has a prior effective filing date of *May 22, 2003*.

The primary reference, Bach, published on November 25, 2004, and has priority back to a provisional application which was filed on October 15, 2003. Therefore, the primary reference has a §102(e) date of only *October 15, 2003*. Thus, Bach is not prior art under §102 with respect to any claim supported by the earlier filed U.S. parent application.

Because independent claim 1 includes limitations which are disclosed in the earlier U.S. application, the primary reference is not prior art to claim 1. Claims 2-6 and 45-48 all depend from claim 1, therefore the primary reference is also not prior art to these claims. Accordingly, withdrawal of this rejection is respectfully requested.

#### *New Claims*

Applicant has further added new dependent claim 46-48 to further define the invention. In particular, claim 46 is directed to where at least a portion of the passage is axially extending through the cylinder. This concept was originally in claim 1, however, this concept was deleted from claim 1 to further clarify the invention. Claims 47 and 48 are directed to concepts the Examiner originally suggested in the Office Action. Support for these claims may be found at least in FIGS. 1A-1C. No new matter has been added.

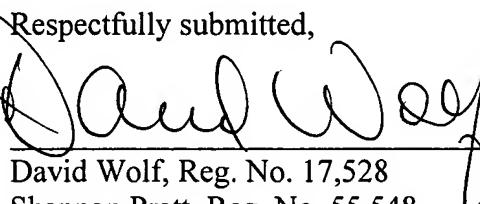
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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